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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------|------------------|
| 10/690,737 | 10/22/2003 | Marion D. Kilgore | 2003-IP-009806 U1 USA | 7677 |
| 30652 | 7590 | 08/04/2006 | EXAMINER | |
| CONLEY ROSE, P.C. 5700 GRANITE PARKWAY, SUITE 330 PLANO, TX 75024 | | | BATES, ZAKIYA W | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3676 | |

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,737

Applicant(s)

KILGORE ET AL.

Examiner

Zakiya W. Bates

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-25 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,078,606.

US' 606 discloses an apparatus that includes an apparatus operatively positionable within a subterranean well comprising: a mandrel 20; a double acting slip 38 and a single acting slip 96 disposed relative to the mandrel, the double acting slip being spaced axially apart from the single acting slip; and a seal element 36 carried on the mandrel. With respect to the depending claims, the reference teaches the limitations as claimed, including wedges, release ring, flanges, and clamp. With respect to claim 13, the reference discloses a packer settable within a tubular structure, the packer comprising: a mandrel 20; first and second axially spaced apart slips 38, 96 disposed relative to the mandrel, the first and second slips being radially outwardly extendable into gripping engagement with the tubular structure when the packer is set therein, the first slip resisting a load applied to the mandrel in a first axial direction and the second slip resisting another load applied to the mandrel in a second direction, opposite to the first direction; a seal element 36 carried about the mandrel, the seal element being radially outwardly extendable into sealing engagement with the tubular

structure when the packer is set therein, a pressure differential in the first axial direction applied to the seal element being resisted by the second slip. With respect to the depending claims, the reference teaches the limitations as claimed, including wedges, release ring, flanges, and clamp. With respect to claim 18, the reference discloses a method of securing an apparatus within a tubular structure disposed in a subterranean well, the method comprising the steps of: disposing a double acting slip and a single acting slip axially spaced apart on the apparatus; positioning the apparatus within the tubular structure; radially outwardly extending the double acting slip and the single acting slip, each of the double acting slip and single acting slip grippingly engaging the tubular structure', and radially outwardly extending a circumferential seal element into sealing engagement with the tubular structure. With respect to the depending claims, the reference teaches the limitations as claimed. See the entire document, especially figures 1-4.

Response to Arguments

3. Applicant's arguments filed 5/15/06 have been fully considered but they are not persuasive. Applicant argues that the US'606 reference does not teach the double acting slip "on" the mandrel, the single slip radially outward engaging the tubular structure, or the seal not "on" the mandrel, which is unfounded. The double-acting slip 38 is considered on the mandrel 20 as shown on at least Fig. 1B. The slip may not be *permanently fixed* or *welded* onto the mandrel, but it is "about" or "on" the mandrel as is the applicant's invention. The single slip radially outwardly engages the tubular

structure by engaging 40, which directly engages the surrounding casing. The seal 36 is considered on the mandrel 20 as shown on at least Fig. 1B. The seal may not be *permanently fixed* or *welded* onto the mandrel, but it is "about" or "on" the mandrel as is the applicant's invention.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

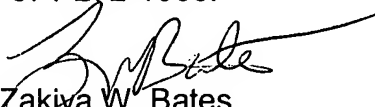
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya W. Bates whose telephone number is (571) 272-7039. The examiner can normally be reached on Monday-Friday, 8:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3676

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Zakiya W. Bates
Primary Examiner
Art Unit 3676

zb

August 2, 2006